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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,936	12/22/1998	Scott Miller	BAYER 6 PI	8682

7590 12/13/2002

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EXAMINER

KUMAR, SHAILENDRA

ART UNIT PAPER NUMBER

1621

DATE MAILED: 12/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/776,936

Applicant(s)  
Miller et al

Examiner  
Shailendra Kumar

Art Unit  
1621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 23, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) 6, 7, 10-12, and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 9, 13-17, and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

This office action is in response to applicants' communication filed in paper # 12, on 9/23/02.

Claims 1-19 are pending in this application and claims 6-7, 10-12 and 18 are withdrawn from the consideration being drawn to the non elected invention, and the restriction requirement was made FINAL in paper # 11.

Applicants argue that searching of the heterocyclic group is redundant in view of the urea and phenyl group as core. The examiner disagrees. It is the heterocyclic group that controls the searching according to the US classification system. For example urea containing phenyl group is classified in class 564, whereas, urea containing phenyl and additionally pyridine containing is classified in class 546.

Rejection of claims under 35 U.S.C. 103 over Kubo et al(US 6,143,764) is hereby withdrawn, subsequent to applicants' arguments that the date of the reference is not good.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 U.S.C. § 103***

1. Claims 1-5, 9, 13-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 9,717,329.

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Instant claims are directed to symmetrical and unsymmetrical substituted diphenyl ureas, for the inhibition of RAF kinase, which is used in the treatment of tumors.

WO'329 teaches structurally similar compounds, composition and method of use as claimed herein, see page 4, formula (I). Note X can be O, and Q can be formula (V), see page 5. Also A can be phenyl. So substituted, the resulting compounds read generically on the instant claimed compounds, when in the instant formula A is phenyl, and R3-R6 can be het aryl. Also see page 16-30, of the reference, various compounds, that reads on the instant claimed compounds. The difference between the reference and herein claimed compounds is that the reference has not made the specific compounds disclosed herein.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to obtain compounds within the generic disclosure of the reference, the motivation being that they are structurally very similar to those claimed herein, and in the same pertinent art, with the reasonable expectation of achieving a successful pharmaceutical composition for treating the tumors, absent evidence to the contrary.

2. The elected species is free of prior art and is allowable. The subject matter within and around the scope of the elected species would be allowed upon applicants' amendment to the claims.

No claim is allowed.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S.Kumar whose telephone number is (703)-308-4519. The examiner can

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normally be reached on Monday to Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703)-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1235.

S.Kumar

12/12/02



SHAIENDRA KUMAR  
PRIMARY EXAMINER  
GROUP 1200